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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,009	02/21/2006	Tsutomu Ichinose	112857531	1746
29175 K&L Gates LLP P. O. BOX 1135 CHICAGO, IL 60690	7590 08/19/2009		<div>EXAMINER</div> <div>YODICEKAS, ANEETA</div>	
			<div>ART UNIT</div> <div>2627</div>	<div>PAPER NUMBER</div>
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

Office Action Summary

Application No.

10/569,009

Applicant(s)

ICHINOSE ET AL.

Examiner

Aneeta Yodichkas

Art Unit

2627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-16, 18-23 and 25-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-16, 18-23 and 25-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/888)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 8/6/09 have been fully considered with the following office action results.

Applicant argues that *Kawakami* disqualifies as a reference for the following reasons: (a) The claimed subject matter of the present application was developed by inventors Tsutomu Ichinose, Shunsuke Furukawa and Takuya Wada. The subject matter of *Kawakami* was developed by another person, specifically, inventors Takashi Kawakami, Toshihide Ooba and Katsuyuki Koizumi; (b) *Kawakami* qualifies as prior art only under 35 U.S.C. §102(e). Specifically, *Kawakami* was filed on April 1, 2003. The present application claims the benefit of Japanese Patent Application No, 2003-319591 filed on September 11, 2003. Thus, *Kawakami* is only prior art to the present application under 35 U.S.C. § 102(e); and (c) The present application and *Kawakami* were, at the time the invention of the present application was made, owned by Sony.

However, it is noted the U.S. Patent Application Publication of *Kawakami* (U.S. Patent Application Pub. No. 2003/0235126 A1) does qualify as a 102(a) reference as the publishing Dec 25, 2003 is before the 371(c) date of the application September 01, 2004.

Applicant has claimed a foreign priority date of 9/11/03, but Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Applicant has provided evidence in this file showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as *Kawakami* at the time this invention was made, or was subject to a joint research agreement at the time this invention was made. However, reference U.S. Patent Application Pub. No. 2003/0235126 A1 additionally qualifies as prior art under another subsection of 35 U.S.C. 102, and therefore, is not disqualified as prior art under 35 U.S.C. 103(c).

Applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the invention of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

3. **Claims 1-6, 8-16, 18-23, and 25-30** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 2003/0235126 A1 to *Kawakami et al.* in view of U.S. Patent No. 5,986,987 to *Taguchi et al.*

As to **claims 1, 18 and 29**, *Kawakami* discloses an information recording processing device, method and information recording medium storing a computer program for performing an information recording process, comprising: a modulated data generating unit (15) and step for generating a modulated recording frame by performing data modulation processing on data to be recorded (Fig. 17, paragraph 0268), where modulation generation unit (15) performs the step of modulation; recording frame characteristic determining means for determining a data characteristic of constituent data of an additional data-corresponding recording frame, wherein said data characteristic represents a state obtained from said additional data-corresponding recording frame (Fig. 14, and 16, paragraphs 0184-0185, paragraph 0170), where the memory transfer controller (3) and the cluster buffer memory (4) determine which frame is in effect and preamble and postamble frames have different characteristics as they are used for different states such as PLL settlement, signal amplitude control and signal offset control; and an additional data-corresponding data controlling unit and step for controlling constituent bits of a data-changeable data part on a basis of: (i) a constituent bit value of additional data; and (ii) the data characteristic of the constituent data of said additional data-corresponding recording frame (Fig. 16, paragraphs 0185-0186, Fig. 14, paragraph 0170), where the memory transfer controller (3) and the cluster buffer

memory (4) control which the additional data-corresponding data or the preamble and suffix frames are used based on the state of the frames or data-corresponding data.

Kawakami is deficient in disclosing said modulation processing including a process of conversion of two-bit information into three-bit information.

However, *Taguchi* discloses said modulation processing including a process of conversion of two-bit information into three-bit information (Fig. 6, columns 7-8, lines 64-1), where modulator (11) converts the two-bit data to three-bit data.

At the time of invention, it would have been obvious to a person of ordinary skilled in the art to have modified the modulated data generating unit as taught by *Kawakami* by including that the modulator converts two-bit data to three-bit data as taught by *Taguchi*. The suggestion/motivation would have been in order for the data to be an accordance with a rule such that the 1/7 modulation of data is met in order to meet the partial response class I characteristics (Taguchi, columns 7-8, lines 64-4).

As to **claims 2, 9, 19, and 26**, *Kawakami* discloses the information recording processing device and method, wherein in said additional data-corresponding data controlling unit and step, and data decoding unit and step, the data part whose constituent bits are controlled is user control data (UCD) (Fig. 7, paragraph 0154), where a 576-byte user control data is used.

As to **claims 3, 10, 13, 20 and 27**, *Kawakami* discloses the information reproduction processing device, information recording medium, and recording process method, wherein the first data characteristic of constituent data of said additional data-corresponding recording frame is a characteristic of whether parity of the constituent

data of the recording frame is even parity or odd parity (Fig. 5, paragraph 0152), where the Reed-Solomon parity code determines whether the recording frame is an even or odd parity, and said additional data-corresponding data controlling unit and step controls the constituent bits of the data-changeable data part on a basis of two conditions of whether the constituent bit value of said additional data is 0 or 1 and whether the parity of the constituent data of said additional data-corresponding recording frame is even parity or odd parity (Fig. 11, paragraph 0162), where the next-generation MD2 system is the controlling unit and the 18-bit error-correcting parity code determines whether the additional data is a 0 or a 1; said additional data decoding unit and step obtains the additional data constituent bit information on a basis of two data characteristic determinations of whether the parity of the constituent data of said additional data- corresponding recording frame is even parity or odd parity and whether parity of constituent data of the specific user control data is even parity or odd parity (paragraph 0122), where the Viterbi decoding method is used which provides a decoding unit and RLL or run length parity preserve/prohibit rmtr, determines whether the parity is even or odd; and said user control data has the data characteristic determined according to two conditions of whether the constituent bit value of said additional data is 0 or 1 and whether the parity of the constituent data of said additional data-corresponding recording frame is even parity or odd parity (Fig. 5 and 7, paragraphs 0152-0154), where user control data is used in determining the parity by the Reed-Solomon parity code.

As to **claims 4 and 21**, *Kawakami* discloses the information recording processing device and method, wherein said additional data-corresponding data controlling unit and step performs control to set parity of the data-changeable data part to one of odd parity and even parity (Fig. 11, paragraph 0162), where the next-generation MD2 system is the controlling unit and the 18-bit error-correcting parity code controls whether the additional data is odd or even.

As to **claims 5, 15 and 22**, *Kawakami* discloses the information recording processing device, medium and processing method, wherein said additional data is set and stored as constituent information of at least one of encryption key information, encryption key generating information, content reproduction control information, and content copy control information for contents stored on said information recording medium (Fig. 54, paragraph 0390), where the encryption unit (72) generates key information (74).

As to **claims 6, 16, and 23**, *Kawakami* discloses the information recording processing device, recording medium, and processing method, wherein said modulated data generating unit and step generates the modulated recording frame by performing a data conversion process satisfying RLL (1, 7) as a run length rule (Paragraph 0122), where RLL (1,7)PP or 1-7pp modulation is used.

As to **claim 8**, *Kawakami* discloses an information reproduction processing device for reproducing information stored on an information recording medium, said information reproduction processing device comprising: a demodulating unit (24) for demodulating data read from the information recording medium; and an additional data

decoding unit for: (a) determining a first data characteristic of an additional data-corresponding recording frame, wherein said first data characteristic represents a state obtained from said additional data-corresponding recording frame (Fig. 14 and 17, paragraphs 0170 and 0257), where based on the characteristics in the preamble and postamble frames, the different states are determined such as PLL settlement, signal amplitude control and signal offset control and this is processed by EFM demodulation unit (24); (b) determining a second data characteristic of a specific user control data read from the information recording medium (Fig. 7, paragraph 0154), where the BIS data code includes user control data; and (c) obtaining additional data constituent bit information on a basis of: (i) said first determined data characteristic which represents the state obtained from said additional data-corresponding recording frame; and (ii) said second determined data characteristic of said specific user control data (Fig. 17, paragraphs 0255-0257), where the EFM demodulation unit (24) and ACIRC decoder (25) receive a signal from RF amplifier (21) from disc (90) and the EFM demodulation unit (24) and ACIRC decoder (25) decode and demodulate the bit information.

Kawakami is deficient in disclosing said data being generated by a modulated recording frame generating process including a process of conversion of two-bit information into three-bit information.

However, *Taguchi* discloses said data being generated by a modulated recording frame generating process including a process of conversion of two-bit information into three-bit information (Fig. 6, columns 7-8, lines 64-1), where modulator (11) converts

the two-bit data to three-bit data. In addition, the same motivation is used as the rejection in claim 1.

As to **claims 11 and 28**, *Kawakami* discloses the information reproduction processing device and method, wherein at least one of encryption key information, encryption key generating information, content reproduction control information, and content copy control information for contents stored on said information recording medium is generated on a basis of the obtained additional data constituent bit information (Fig. 54, paragraph 0390), where encryption unit (72) generates key information (74).

As to **claim 12**, *Kawakami* discloses an information recording medium storing: modulated data based on a plurality of recording frames (Fig. 17, column 25, lines 8-10), where modulation data generating unit (15) modulates the data; and user control data having a data characteristic determined on a basis of a constituent bit value of additional data and a data characteristic of constituent data of a specific additional data-corresponding recording frame selected from the plurality of recording frames, wherein said data characteristic represents a state obtained from said specific additional data-corresponding recording frame (Fig. 7, paragraph 0154), where user control data has 576-bytes, which is several bits and based on the value of the bits in the frames the state of the frame is determined.

Kawakami is deficient in disclosing wherein said modulated data is generated by performing a process of converting two-bit information into three-bit information.

However, *Taguchi* discloses wherein said modulated data is generated by performing a process of converting two-bit information into three-bit information (Fig. 6, columns 7-8, lines 64-1), where modulator (11) converts the two-bit data to three-bit data. In addition, the same motivation is used as the rejection in claim 1.

As to **claim 14**, *Kawakami* discloses the information recording medium, wherein the data characteristic determined for said user control data is a data characteristic of whether parity of constituent data of said user control data is even parity or odd parity (Fig. 5, paragraph 0152), where the Reed-Solomon parity code determines whether the recording frame is even or odd parity, and the user control data having the parity determined on a basis of the constituent bit value of said additional data and the data characteristic of the constituent data of the specific additional data- corresponding recording frame selected from said plurality of recording frames is stored (Fig. 5 and 7, paragraphs 0152-0154), where user control data is used in determining the parity by the Reed-Solomon parity code.

As to **claim 25**, *Kawakami* discloses an information reproduction processing method for reproducing information stored on an information recording medium, said information reproduction processing method characterized by comprising: a demodulating step of demodulating data read from the information recording medium (Fig. 17, paragraph 0257), where demodulation unit (24) performs the demodulation step; and an additional data decoding step of determining a first data characteristic of an additional data-corresponding recording frame, wherein said first data characteristic represents a state obtained from said additional data-corresponding recording frame

(Fig. 14, paragraphs 0170-0171), where based on the characteristics in the preamble and postamble frames, the different states are determined such as PLL settlement, signal amplitude control and signal offset control; and determining a second data characteristic of a specific user control data read from the information recording medium (Fig. 7, paragraph 0154), where the BIS data code includes user control data; and obtaining additional data constituent bit information on a basis of the two determined data characteristics (Fig. 17, paragraphs 0255-0257), where the EFM demodulation unit (24) and ACIRC decoder (25) receive a signal from RF amplifier (21) from disc (90) and the EFM demodulation unit (24) and ACIRC decoder (25) decode and demodulate the bit information.

Kawakami is deficient in disclosing said data being generated by a modulated recording frame generating process including a process of conversion of two-bit information into three-bit information.

However, *Taguchi* discloses said data being generated by a modulated recording frame generating process including a process of conversion of two-bit information into three-bit information (Fig. 6, columns 7-8, lines 64-1), where modulator (11) converts the two-bit data to three-bit data. In addition, the same motivation is used as the rejection in claim 1.

As to **claim 30**, *Kawakami* discloses an information recording medium storing a computer program for reproducing information stored on an information recording medium, said computer program structured to cause an apparatus to: demodulate data read from the information recording medium; and determine: (i) a first data characteristic

of an additional data-corresponding recording frame, wherein said data characteristic represents a state obtained from said additional data-corresponding recording frame (Fig. 14 and 17, paragraphs 0170 and 0257), where based on the characteristics in the preamble and postamble frames, the different states are determined such as PLL settlement, signal amplitude control and signal offset control and this is processed by demodulating unit (24); and (ii) a second data characteristic of a specific user control data read from the information recording medium (Fig. 7, paragraph 0154), where the BIS data code includes user control data; and obtain additional data constituent bit information on a basis of the two determined data characteristics (Fig. 17, paragraphs 0255-0257), where the EFM demodulation unit (24) and ACIRC decoder (25) receive a signal from RF amplifier (21) from disc (90) and the EFM demodulation unit (24) and ACIRC decoder (25) decode and demodulate the bit information.

Kawakami is deficient in disclosing said data being generated by a modulated recording frame generating process including a process of conversion of two-bit information into three-bit information.

However, *Taguchi* discloses said data being generated by a modulated recording frame generating process including a process of conversion of two-bit information into three-bit information (Fig. 6, columns 7-8, lines 64-1), where modulator (11) converts the two-bit data to three-bit data. In addition, the same motivation is used as the rejection in claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aneeta Yodichkas whose telephone number is (571) 272-9773. The examiner can normally be reached on Monday-Thursday 8-5, alternating Fridays, 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jorge L Ortiz-Criado/
Primary Examiner, Art Unit 2627

/A.Y./
8/13/09

